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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,158	04/22/2004	David Loverock	1669-40	5736
1059	7590	03/17/2005	EXAMINER	
BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA			EDWARDS, LAURA ESTELLE	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 03/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,158

Applicant(s)

LOVEROCK, DAVID

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16, and 18-20 is/are rejected.
- 7) ☒ Claim(s) 8 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 083004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Claim Rejections - 35 USC § 112

Claims 4, 13, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 4, 13, and 19, it is unclear what is meant by the pad having a footprint and an ice-contact surface such that an ice-contact surface area is smaller than the footprint.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Graff (US 3,990,800).

Graff teaches an ice marking device comprising the combination of a wand or rod (10) for holding by an operator, a conduit system (24) on the wand for transporting coloring liquid or paint, the conduit system defining a passage having a passage inlet connectable to a source of coloring liquid or paint (not numbered) and a passage outlet (not numbered) in communication with a distributing header (22), wherein the conduit system is configured to provide fluid flow characteristics selected so that when a valve (25) in fluid communication with the conduit system is closed, paint is substantially prevented from flowing through the passage outlet; and a pad

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surface disposed on a roller (18) is positionable immediately downstream from the passage outlet, wherein the pad surface is configured to receive paint from the passage outlet, wherein the pad has an ice contact face or outer circumferential surface for distributing paint onto the ice surface.

With respect to claims 3 and 11, it appears that the coloring liquid or paint as supplied from the source or supply container (12) flows downward through the conduit system to the padded roller (18) via force of gravity because no pump is utilized.

With respect to claim 9, see above and container (12) includes an outlet (not numbered) in fluid communication with the conduit system, header, and padded roller (18).

With respect to claim 12, see valve (25) is connected in fluid communication with the container outlet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4-7, 10, 13-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graff (US 3,990,800).

Graff teaches an ice coloring or painting device as mentioned above but Graff is silent concerning the passage outlet of the conduit system having at least one outlet aperture of such a small cross-section so as to prevent air from flowing upstream into the conduit system. However, it is within the purview of one skilled in the art to make the passage outlet aperture of a size sufficient so as to control fluid flow therethrough. In light of the use of a coloring liquid or paint which appears to be a non-viscous material, one of ordinary skill in the art would expect to make the passage outlet aperture of a sufficiently small size to enable a desired fluid flow of the coloring liquid or paint to coat a substantial area of ice.

With respect to claim 4, Graff recognizes that the padding on the roller is made from foamed plastic, rubber or sponge as evidenced by col. 3, lines 10-15 such that one of ordinary skill in the art would recognize the pad being of an open or porous receiving structure.

With respect to claim 5, Graff discloses that a cover is placed on the cylindrical surface of the roller as evidenced by col. 3, lines col. 3, lines 10-15 such that one of ordinary skill in the art would recognize that the pad or covering is removable from the roller and therefore from the wand.

With respect to claims 6 and 7, even though Graff recognizes the use of piping or tubing (i.e., hose) in the painting device (see col. 1, lines 60-64), Graff is silent concerning parts (i.e., the wand and conduit system) of the painting device being separable. However, it would have been obvious to one of ordinary skill in the art to make the wand or the conduit system separable

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since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

With respect to claim 18, Graff teaches an ice painting or marking device comprising a painting head (14), the head including a distributor (22) in an upper portion, a roller removably connected to the lower portion, and a chamber defined by two end plates (16) in the area between the upper and lower portion, wherein the roller includes a pad surface placed on the roller, the padded roller being configured to receive paint from an outlet or distributor (22), and the padded roller having an ice contact face or outer circumferential surface for distributing paint onto the ice surface. Graff is silent concerning the painting head being removably connectable to the body portion of the wand. However, for reasons mentioned in the previous paragraph, it is within the level of ordinary skill in the art to make a formerly integral structure separable as in the present case, to make the painting head including the parts therein separable from the wand body portion so as to enable different types of rollers and/or distributors to be used with the wand is deemed an obvious modification such that patentability would not result.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US 3,918,820).

Kim teaches a paint applicator assembly comprising a painting head (10) defining a chamber therein, the painting head being removably connected to a wand or handle (54) via a connecting member (56), the chamber having an outlet (26), and the pad is removably connected to the painting head (see col. 3, lines 48-62), the pad configured to receive paint from the outlet, and wherein the pad has a face for contacting a surface to be painted. Even though Kim does not

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teach the use of the device for applying paint to ice, it would have been obvious to one of ordinary skill in the art to utilize the Kim paint applicator on any surface capable of receiving paint. Applicant's recitation of the painting device in the preamble of the claim has been given no patentable weight as the basis of the claim has been read to only include that structure to the assembly that follows the term "comprising".

With respect to claims 19 and 20, Kim recognizes that the pad (12) can be made from foamed resin, sponge, or fibrous pile fabric as evidenced by col. 3, lines 52-62 such that one of ordinary skill in the art would recognize the pad being of an open or porous receiving structure.

Allowable Subject Matter

Claims 8 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 would be allowable because there is no teaching or suggestion in the prior art of an ice painting device comprising the combination of wand for holding by an operator, a conduit system associated with the wand for transporting the paint, the conduit system defining a passage having a passage inlet and a passage outlet, wherein the passage inlet is fluidly connectable to the source outlet, wherein the conduit system is configured to provide fluid flow characteristics selected so that when the valve is closed, paint is substantially prevented from flowing through the passage outlet; and a pad positionable immediately downstream from the passage outlet, wherein the pad is configured to receive paint from the passage outlet, wherein the pad has an ice contact face for distributing paint onto the ice surface wherein the pad includes first body portion

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and a first painting head, wherein the pad is a first pad is configured for painting a line having a first width and wherein the first pad is connected to the first painting head, and wherein the painting device further includes a second painting head wherein the second painting head is connectable with the first body portion, and wherein the second painting head has a second pad mounted thereto, wherein the second pad is configured for painting a line having a second width.

Claim 17 would be allowable because there is no teaching or suggestion in the prior art of an ice painting device comprising the combination of a container for holding paint to paint an ice surface, wherein the container has a container outlet; a wand for holding by an operator; a conduit system associated with the wand for transporting the paint, the conduit system defining a passage having a passage inlet and a passage outlet, wherein the passage inlet is fluidly connectable to the container outlet; a valve positioned in the conduit system upstream from the passage outlet, wherein the valve is selectively closeable to prevent a flow of paint therepast; and a pad positionable immediately downstream from the passage outlet, wherein the pad is configured to receive paint from the passage outlet, the pad has an ice contact face for distributing paint onto the ice surface, wherein the portion of the conduit system that is downstream from the valve is configured to provide fluid flow characteristics selected so that when the valve is closed, paint is substantially prevented from flowing through the passage outlet, wherein the wand includes a first body portion and a first painting head, wherein the pad is a first pad is configured for painting a line having a first width and wherein the first pad is connected to the first painting head, and wherein the painting device further includes a second painting head wherein the second painting head is connectable with the first body portion, and

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wherein the second painting head has a second pad mounted thereto, wherein the second pad is configured for painting a line having a second width..

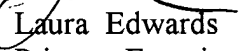
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents disclose the state of the art with respect to ice coating devices: Belcourt et al (US 5,127,164), Vacanti (US 5,478,393), and Robinson et al (US6,053,426).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Laura Edwards
Primary Examiner
Art Unit 1734

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March 11, 2005